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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,151	01/14/2004	Michael P. Casey	247079-000292USPT	3165

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EXAMINER	
KIM, ANDREW	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
07/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/757,151	CASEY ET AL.	
	Examiner	Art Unit	
	ANDREW KIM	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22,24,26-33,36-43 and 46-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22, 24, 26-33, 36-43, 46-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In view of the appeal brief filed on 3/6/09, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

***.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 26-27, 29, 30, 32, 33, 36-37, 41-43, and 47-48 rejected under 35 U.S.C. 102(b) as being anticipated by Gilmore et al. (US 6347996 B1).

Claims 22, 26, 27, 29, 33, 37, 41, 43, 47, 43. Gilmore discloses a method of conducting a wagering game on a gaming machine controlled by a controller in response to a wager, the method comprising:

displaying on a display device of the gaming machine, an assemblage of selectable tiles that conceal an associated plurality of icons, the plurality of icons including a plurality of game-theme icons and a wild icon (Abstract, fig.5 and 6, col. 4:10-67) the game-theme icons have been interpreted as the cards/tiles that turn over and the associated award value;

receiving successive selections of the tiles (Abstract, fig.5 and 6, col. 4:10-67);

selectively revealing a first group of related game-theme icons associated with the selected tiles, the first group including at least two first tiles from the assemblage of selectable tiles, each of the first tiles having a first game-theme icon, the first game-theme icon from one of the first tiles matching the first game-theme icon from another one of the first tiles (Abstract, fig.5 and 6, col. 4:10-67);

selectively revealing a second group of related game-theme icons associated with the selected tiles, the second group being different from the first group, the second group including at least two second tiles from the assemblage of selectable tiles, each of the second tiles having a second game-theme icon, the second game-theme icon from one of the second tiles matching the second game-theme icon from another one of the second two tiles (Abstract, fig.5 and 6, col. 4:10-67);

selectively revealing the wild icon associated with the selected tiles after revealing the first group and the second group (Abstract, fig.5 and 6, col. 4:10-67); and

in response to revealing the wild icon, simultaneously awarding a first award and a second award, the first award being based on the at least two first tiles of the first group, the second award being based on the at least two second tiles of the second group (Abstract, fig.5 and 6, col. 4:10-67).

Claims 30, 36, 48. Gilmore discloses wherein the gaming machine comprises a video slot machine, and wherein displaying the assemblage of selectable tiles includes displaying a video generated assemblage of selectable tiles (Abstract, fig.5 and 6, col. 4:10-67).

Claim 32. Gilmore discloses wherein the first award comprises a first credit amount, and wherein the second award comprises a second credit amount (Abstract, fig.5 and 6, col. 4:10-67).

Claim 42. Gilmore discloses wherein the assemblage of selectable tiles is arranged as a matrix having multiple rows and columns (Abstract, fig.5 and 6, col. 4:10-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 24, 28, 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore et al. (US 6347996 B1) in view of Schneider et al. (US 6,089,976).

Claims 24. Gilmore substantially discloses the invention as claimed but fails to explicitly teach displaying a legend adjacent to the assemblage of selectable tiles, the legend displaying a plurality of matches and respective awards, each of the plurality of matches including a plurality of related game-theme icons.. In an analogous reference, Schneider teaches having a pay table to provide the player with the winnings (Schneider, col. 3:19) and credit meter 42 (Schneider, col. 4:62). Schneider is an analogous reference because Schneider discloses displaying a plurality of selectable tiles that are selectively revealed to the player. One of ordinary skill in the art would have seen the benefit of adding a legend or paytable to entice the player by showing the player how much the player may win with a single wager. The paytable also functions as an easy-to-understand table that enables the player to translate what he sees on the display to possible money in his account thereby

enticing the player to play the game more increase casino profits. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a legend or paytable to entice the player to play the game and increase casino profits.

Claims 28, 40, 46. Gilmore substantially discloses the invention as claimed but fails to explicitly teach wherein the first award comprises a first number of free reel spins, and wherein the second award comprises a second number of free reel spins. However, it is well known and obvious in the art at the time of the invention to provide free spins as awards. Therefore, it would have been obvious to one or ordinary skill in the art at the time of the instant invention to modify the monetary award in Gilmore to the equivalent of free spins as the award to enhance player appeal and allow the player to have more chances to win a prize.

Claims 31, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore et al. (US 6347996 B1) in view of Loose et al. (US 6,517,433).

Claims 31, 38 and 39. Gilmore substantially discloses the invention as claimed but fails to explicitly teach a flat panel transmissive display configured to overlay the assemblage of selectable tiles upon a portion of the plurality of electro-mechanical symbol-bearing reels. Instead, Gilmore discloses that it mostly comprises a video display. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gilmore with a display over EM reels so that it is capable of effecting extravagant changes to the appearance of the display area and displaying the graphics within the player's focus (Loose, 1:50-55)

Response to Arguments

With respect to the arguments associated with the background of this pending application, specifically regarding the different groups, please see below.

The applicant argues that the pending application claims that the two pairs of icons that are selected are different and distinct from Gilmore's icons (second paragraph page 12 of 28 of brief) and that the claims were amended to further clarify that multiple awards are awarded in response to a revealing wild icon subsequent to revealing two pairs of game-theme icons, each pair including its own matching game-theme icons (first paragraph page 13 of 28 of appeal brief).

In response, the Examiner respectfully asserts that the claims neither state that the game icon of one pair or group is different from the other pair nor do the claims state, "each pair including its own matching icons." The claims only state that the two pairs or groups are different. Therefore, two tiles can be matching without having the same icon and a tile from one group can also be a tile from another group and still have two different groups as long as the other tile is not the same.

For example, there are 4 tiles: T(1), T(2), T(3), T(v). T(1), T(2) and T(3) are the same-image icons. T(v) is a variable icon that can match with any of the same-image icons.

A player selects T(1) and T(2) (Group A) from grid display. Player then selects T(v). The player now has selected T(1), T(2), and T(v). T(2) and T(v) are group B. T(2) and T(v) are not same-image icons but the variable icon T(v) can match with any icon

thus making Group B different than Group A. Now T(3) is automatically revealed to the player and then the map under these icons is revealed and the player receives a pick. This example reads on the pending application and is disclosed by Gilmore.

What may be confusing about the previous example is that Gilmore's "wild" icon is analogous to one of the pending application's second group icon while the pending application's "wild" icon is analogous to Gilmore's third same-image icon. This interpretation was used because the term "wild" was not clearly defined in the claims or in the specification. Instead, the Examiner used the term in light of the term "wild" card slot in a tournament in which the wild is a position that may be reached by many different items, teams, or tiles and not simply the best (or in the case of tiles, a straight, same-image match). This interpretation is unneeded for claim 43 because claim 43 lacks the term "after." Therefore, the pending application is anticipated by Gilmore.

Regarding the simultaneous award argument in page 13 of 28, the simultaneous award in Gilmore may be the revealing of the map underneath the tiles and/or the pick which is associated with finding a matching set and enables bonuses such as 50 times the lines bet or 100 times the line bet (4:64).

Regarding the argument with respect to claims 22, 26-27, 29-33, 36-39, 41-43, and 47-48, specifically with respect to the advisory action, the Examiner respectfully asserts that the term "entirely different" found in the advisory action referred to the fact that the tiles which compose the two groups need not be mutually exclusive and that a tile or two may be shared between the two groups and still be different.

Regarding the argument with respect to claims 22, 26-27, 29-33, 36-39, 41-43, and 47-48, specifically with respect to the different group argument, the Examiner respectfully asserts that the claims state that the two groups are different but the claims ***do not*** state that the first game-theme icon and second game-theme icon are different, thereby allowing the interpretation that the first and second game-theme icon may be the same.

Regarding the argument with respect to claims 22, 26-27, 29-33, 36-39, 41-43, and 47-48, specifically respect to the Gene and Debbie icon examples, the Examiner respectfully asserts that the examples should not be read into the claim which only states a first and second game-theme icon that may or may not be identical as discussed above.

Regarding the argument that Revealing of Map is not an Award, the Examiner respectfully asserts that one of ordinary skill in the art interprets an award as anything of value or benefit. As an example, US 2003/0050108 paragraph 22 states, "The award may be credits, coins, or anything else." US 20030040960 paragraph 30 states, "The term 'prize', refers to anything that can be given as an award, for example: points, miles, credits, an entry to a sweepstake, a car." US 2006/0172792 paragraph 101 states, "As mentioned awards can be anything of value such as a tangible item (e.g., a car), a service (e.g., a fully paid for vacation), money, etc." In addition, 5:20-25 of Gilmore indicates another embodiment in which the removed tiles are the only ones eligible to award a bonus and therefore further indicates that a map revealing award is significant,

because if, in this embodiment, no tiles were removed the player will not receive a significant monetary award.

Regarding the argument with respect to claims 29, 41 and 47, specifically in respect to "multiplying a credit amount associated with a winning outcome," the Examiner respectfully asserts that the player's total bet is inherently associated with the winning outcome. Firstly, a player's bet is the equivalent of a player's credit bet or credits wagered (credit amount). Secondly, a player's total bet or line bet (or amount of credits to wager) is inherently associated with a winning outcome because without a player bet, the gaming machine will not be initiated and a winning outcome will not be produced.

Regarding the argument with respect to the 103 rejection, specifically with respect to the legend, the Examiner respectfully asserts that the legend as defined in claim 24, must simply display a plurality of matches and respective awards which is clearly shown in figure 3 of Schneider and figure 7 of Gilmore. Schneider clearly shows matching game-theme icons (12 coins and 50 coins) and also respective awards (12 coins and 50 coins). Gilmore clearly shows matching game-theme icons (100x line bet, 300x line bet) and also respective awards (641 credits in top left corner).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KIM whose telephone number is (571)272-1691. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

7/21/2009 /A. K./
Examiner, Art Unit 3714